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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,385	11/01/2001	Kunio Shimizu	56232.10 [4874]	9078
7590	10/23/2003		EXAMINER	
Squire, Sanders & Dempsey L.L.P. Suite 300 One Maritime Plaza San Francisco, CA 94111			RAJGURU, UMAKANT K	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,385	SHIMIZU ET AL.	
	Examiner	Art Unit	
	Umakant K. Rajguru	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-14,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 8 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

1. Claim under examination are 1-17.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a). (US 6320042).

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over

UKR Michihata et al. (US 6320042)

Michihata discloses polarizing plate protective cellulose triacetate film (abstract). Film contains a plasticizer at 0.2 to 10.0 g per sq meter of the film (col. 10, lines 5-8).

It is noted that patentee does not mention variation in wt (of instant claim 1) and moisture permeability (of instant claim 3). It is the examiner's position that film of patentee satisfies these limitations inherently unless proved otherwise. Hence it would have been obvious to follow teachings of this patentee and arrive at (claimed) invention.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07020317.

JP '317 discloses a polarizing plate provided with a polarizing film and protective films. Protective films are cellulose ester based and have a plasticizer at 3-9%wt.

Following the same reasoning (as in item 3 above) it would have been obvious to follow teachings of JP '317 and arrive at (claimed) invention.

5. Claims 4, 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP 07020317 each in view of Russo (US 4262040).

Disclosures of Michihata and JP '317 have been presented earlier. Michihata and JP '317 do not mention any of specific plasticizers of instant claim 4.

Russo describes a decorative coating (col. 2, lines 16-31). The composition of coating includes organic solvents, balsams and plasticizers (col. 4, lines 1-32). Rosin esters happen to be suitable plasticizers.

It would therefore have been obvious to use the rosin esters of Russo, as suitable plasticizer, in the film of Michihata or JP '317 with the expectation of obtaining enhanced flow during formation of film.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP '317 each in view of Russo (US 4262040) as applied to claims 4 and 5 above, and further in view of Coopridge et al (US RE 37563).

Michihata or JP '317 together with Russo does not disclose hydrogenated rosin.

Cooprider discloses partially crosslinked microspheres and an adhesive using them. Patentee mentions hydrogenated rosin esters as suitable plasticizers (col. 9, lines 32-37).

Therefore it would have been obvious to include hydrogenated rosin in the film of Michihata or JP '317 to enhance adhesion.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP '317 each in view of Russo (US 4262040) as applied to claim 4 above, and further in view of Bekele (US 5202188).

Michihata or JP '317 together with Russo fails to mention (claimed) epoxy plasticizer.

Bekele discloses film comprising vinylidene chloride and a plasticizer containing epoxy groups (col. 7, line 20 to col. 8, line 2; col. 8, lines 23-25).

Hence it would have been obvious to use the epoxy plasticizer of Bekele as a preferred plasticizer in film of Michihata or JP '317 to improve flow during extrusion of film.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP '317 each in view of Russo (US 4262040) as applied to claim 4 above, and further in view of Ueda et al (US 5698614).

Michihata or JP '317 together with Russo fails to disclose (claimed) ketone resin as plasticizer.

Ueda describes an ink composition comprising a ketone resin (abstract; col. 3, lines 16-18).

Therefore it would have been obvious to use ketone resin in the film of Michihata
NKK or JP '317 to improve stability, leveling effect, water resistance and adhesion.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP '317 each view of Russo (US 4262040) as applied to claim 4 above, and further in view of Honjo et al (US 4218362).

Michihata or JP '317 together with Russo fails to mention (claimed) p-toluenesulfonamide resin as plasticizer.

Honjo discloses a powder marking agent in which p-toluenesulfonamide is used as a plasticizer (col. 5, liens 44-46).

Hence it would have been obvious to use in the film of Michihata or JP '317, p-toluenesulfonamide as plasticizer to achieve better flow properties.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP '317 each in view of Russo (US 4262040) as applied to claims 1 and 2 above, and further in view of Coopridier et al (US RE 37563).

Please see item 6 for this rejection.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al US 6320042) or JP '317 as applied to claim 1 above, and further in view of Bekele (US 5202188).

Please see item 7 for this rejection.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP '317 as applied to claim 1 above, and further in view of Ueda et al (US 5698614).

Please see item 8 for this rejection.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michihata et al (US 6320042) or JP '317 each in view of Russo (US 4262040) as applied to claims 4 and 11 above, and further in view of Honjo et al (US 4218362).


Please see item 9 for this rejection.

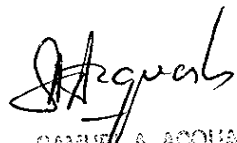
14. Claims 8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru whose telephone number is 703-308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


U. K. Rajguru/mn
October 10, 2003


SAMUEL A. ACQUAH
PRIMARY EXAMINER
GROUP 1700